

**REMARKS**

The Office Action dated 8 September 2004 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 4-16 were previously cancelled without prejudice or disclaimer, and claims 1-3 and 17-24 remain as previously presented. Thus, claims 1-3 and 17-24 are respectfully submitted for consideration by the Examiner.

The drawings were objected to under 37 C.F.R. § 1.83(a) for failing to include labeled diagram boxes. Submitted concurrently herewith is a Transmittal of Drawing Replacement Sheets to Correct Informalities that includes two sheets of Replacement Drawings that are respectfully submitted to overcome the objection. In particular, the diagram boxes for features 114, 115, 117 and 122 have been labeled in accordance with the Examiner's helpful suggestion.

The drawings were also objected to under 37 C.F.R. § 1.83(a) for allegedly failing to show every feature of the invention specified in the claims. This objection is respectfully traversed in view of the aforementioned Replacement Drawings and the above amendment to the specification. In Applicants' specification as originally filed, Figure 1 is described in the Brief Description of Drawings as a schematic showing of "an automotive evaporative leak detection system in the context of an automotive fuel system" (page 3, lines 6-7). Additionally, Applicants specification as originally filed states that "[t]he normally closed canister purge valve 115 is coupled to manifold (intake) 118" (page 7, lines 11-12). It is respectfully submitted that one of skill in the art at the time the present application was filed would understand that, in the context of an automotive fuel system, an intake manifold refers to a feature of an internal combustion engine. Moreover, it is respectfully submitted that one of skill in the art at the time the present application was filed would implicitly understand that, when viewing Figure 1, the box to which "manifold (intake) 118" is coupled is representative of an internal combustion engine.

Nevertheless, in order to advance prosecution, reference numeral 119 has been added to indicate the representative showing of the internal combustion engine in Figure 1, and the specification has been correspondingly amended to identify reference numeral 119 as indicating an internal combustion engine. It is respectfully submitted that no new matter

has been added, and that support for the addition of reference numeral 119 may be found in the specification and drawings as originally filed, for at least the reasons described above.

As such, withdrawal of the drawing objections is respectfully requested.

Claims 1-3 and 17-24 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Office Action alleges that the application as originally filed fails to provide support for “supplying from the tank fuel being combusted by the automotive vehicle,” as recited in Applicants’ claims 1 and 17, “combusting in the internal combustion engine fuel from the fuel tank,” as recited in Applicants’ claim 18, and “supplying fuel from the fuel tank to the engine,” as recited in Applicants’ claim 23. These rejections are respectfully traversed in view of the following comments.

It is respectfully submitted that Applicants’ specification and drawings as originally filed disclose an automotive fuel system (*see* page 3, lines 6-7, and Figure 1) that inherently includes supplying fuel from a tank to an internal combustion engine, and that an internal combustion engine operates by combusting fuel. Simply put, these are inherent properties and functions that a person skilled in the art of automotive fuel systems would understand. The Manual of Patent Examining Procedures § 2163.07 states:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

Further, it is respectfully submitted that a person skilled in the art of automotive fuel systems would clearly recognize in Applicants’ disclosure a description of the features at issue in Applicants’ claims. The Manual of Patent Examining Procedures § 2163.04 states:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the

art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion (see MPEP § 2163 for examination guidelines pertaining to the written description requirement). These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

Therefore, it is respectfully submitted that the Office Action has failed to establish a *prima facia* case to support the rejections under 35 U.S.C. § 112, first paragraph, and that these rejections should be withdrawn with regard to independent claims 1, 17, 18 and 23, and that these claims be allowed. Claims 2, 3, 19-22 and 24 depend, either directly or indirectly from one of the independent claims and are respectfully submitted to also be allowable for at least the same reasons as claims 1, 17, 18 and 23, as well as for the additionally recited features that further distinguish Applicants' invention.

The Examiner is also reminded that the Manual of Patent Examining Procedures § 2163.04 additionally states that:

Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply.

The Office Action also makes two inaccurate assertions that will now be addressed. First, the Office Action asserts that "there clearly is no indication of supplying fuel while the leak testing is being performed as is now claimed." The Examiner is respectfully requested to particularly point out the portion(s) of the claims from which this assertion is derived. Second, the Office Action refers to three conditions that are stated in Applicants' specification at page 1,

lines 25-31, and asserts that “Applicants’ new step of ‘supplying fuel’ violates” two of these conditions. Page 1, lines 25-31, is in the “Background of the Invention” section of Applicants’ specification as originally filed, and the conditions described therein are with regard to an established leak detection system as opposed to Applicants’ invention.

Finally, under the heading of “Double Patenting,” the Office Action suggests considering “US Patent No. 6,089,081 when revising the present invention.” However, the Office Action sets forth neither a statutory double patenting rejection nor a non-statutory obviousness-type double patenting rejection.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this Application and the prompt allowance of claims 1-3 and 17-24.

Should the Examiner feel that there are any issues outstanding after consideration of this reply, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution of the application.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

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By:



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